

Response to the Final Office Action dated September 9, 2003
Application Serial No. 09/539,228

REMARKS

This amendment is intended as a full and complete response to the Final Office Action dated September 9, 2003. In the Final Office Action, the Examiner notes that claims 1-8 are pending, of which claims 1-8 stand rejected. By this amendment, claims 2-4 and 8 are amended; and claims 1, 5, 6, and 7 continue unamended.

In view of both the amendments presented above and the following discussion, the Applicants submit that none of the claims now pending in the application are anticipated or obvious under the respective provisions of 35 U.S.C. §§102 and 103. Thus, the Applicants believe that all of these claims are now in allowable form.

On November 3, 2003, the Applicants, through their attorney, had an interview with the Examiner. The Applicants understand that the Examiner has a busy schedule and appreciates the time granted for the interview. During the interview, the Examiner indicated that the claims could be amended to clarify that the demand cast data streams include interactive program guide ("IPG") pages. The Examiner also indicated that such an amendment would likely overcome the references cited by the Examiner. In view of the discussion with the Examiner, the Applicants have amended the claims to clarify that the demand cast data streams include IPG pages. Support for the amendments to the claims can be found in the Applicants' specification at least on page 14, line 30 to page 15, line 22.

RESPONSE TO THE EXAMINER'S "RESPONSE TO ARGUMENTS"

The Examiner indicated that the arguments previously presented with respect to claims 1 and 5-7 were considered but were moot in view of new ground(s) of rejection. On page 2 and 3 of the Office Action, the Examiner indicated that Eyer et al. (U.S. Patent No. 5,801,753 issued September 1, 1998) ("Eyer") and Chernock et al. (U.S. Patent No. 6,314,569 issued November 6, 2001) ("Chernock") were "inter-related because they deal with user set top terminals displaying information that is packetized, multiplexed, and transmitted with video data." As such, the Examiner indicated that it would have been obvious to a person skilled in the art to combine Eyer and Chernock. As indicated below, the Applicants maintain that it would not have been obvious to a person skilled in the art to combine Eyer and Chernock.

Response to the Final Office Action dated September 9, 2003
Application Serial No. 09/539,228

Rejections Under 35 U.S.C. §103

The Examiner rejected claims 1, 2, and 5 under 35 U.S.C. 103(a) as being unpatentable over Eyer in view of Wolf et al. (U.S. Patent No. 5,461,415 issued October 24, 1995) ("Wolf"); and claims 3 and 4 under 35 U.S.C. 103(a) as being unpatentable over Eyer in view of Wolf and further in view of Chernock.

A. Claims 1, 2, and 5

The Examiner rejected claims 1, 2, and 5 under 35 U.S.C. 103(a) as being unpatentable over Eyer in view of Wolf. The Applicants traverse the rejection.

The Applicants incorporate herein the arguments presented in the previous Response filed June 12, 2003 in response to the Office Action mailed February 14, 2003. In addition to the previously presented arguments, there are additional distinctions between the Applicants' invention and the above-cited references.

Eyer discloses a method and apparatus that transmit a trickle data stream and a demand data stream. The trickle data stream contains current programming information and is stored in memory of a set-top terminal. Because the information transmitted by the trickle data stream is retrieved from memory, the trickle data stream is transmitted at a slower rate than the transmission of the demand data stream. The demand data stream contains current programming information and future programming information.

Whenever a user desires to view a portion of the program guide database that is not stored in the decoder memory, the desired portion is acquired from the high speed demand stream. Thus, trickle data does not need to be present for programs scheduled farther in the future than can be held in the available decoders having the largest IPG RAM allocations. All other data is provided via the demand stream. See Eyer at col. 6, lines 5-12.

In short, the method and apparatus allow a user to access future programming information not stored in the user's set-top box. When a user requests future programming information, the demand data stream is accessed while leaving the trickle data stream untouched.

The addition of Wolf does not correct the shortcomings of Eyer. Wolf discloses a method and system that allocates buffer memory for pausing and resuming a video program. Wolf broadcasts a video program (e.g., a live broadcast of a baseball game)

Response to the Final Office Action dated September 9, 2003
Application Serial No. 09/539,228

to a group of users and also sends a duplicate transmission of the broadcast to a buffer memory for the group. A user in the group can pause and resume the broadcast. Upon a request to resume the broadcast, Wolf pointcasts the unviewed portion from the buffer to the user requesting that the paused broadcast be resumed. Thus Wolf allows a user to index into the video content where the user left. If multiple users pause the broadcast at different times and resume the transmission then the other users will not all receive the same pointcast transmission. As a result, the transmissions disclosed in Wolf must be transmitted at a particular point in the broadcast (i.e., to transmit the unviewed content for the requesting user). See Wolf at col. 3, lines 27-41; col. 3 line 63 to col. 4, line 21; and Wolf's Figure 4.

In contrast, the Applicants disclose a digital message and method for allowing multiple users to view IPG pages.

The Applicants' claim 1, recites in pertinent part:

a list of demand-cast streams that are available in a transport stream being transmitted from the transport stream generator each of said demand cast streams comprising imagery associated with a respective program guide page; and

a different demand-cast stream added to said list in response to a request by said terminal, said different demand-cast stream being accessible from said list as long as at least one other terminal is associated with said different demand-cast stream. (Emphasis added).

In addition, the Applicants' claim 5, recites in pertinent part:

sending to the terminal a list of demand-cast streams that are available in a transport stream being transmitted from the transport stream generator each of said demand cast streams comprising imagery associated with a respective program guide page, wherein said list comprises a different demand-cast stream requested by the terminal said different demand-cast stream being accessible from said list as long as one other terminal is associated with said different demand-cast stream." (Emphasis added).

The Applicants' claims 1 and 5 recite that the demand-cast streams include IPG pages. In one embodiment, a different demand-cast stream and associated IPG page not included in a current list of demand-cast streams (each demand-cast stream in the list also has an associated IPG page) is requested by a terminal. As a result of the terminal request, the terminal is associated with the different demand-cast stream. In addition, the different demand-cast stream is included in the list and made available to

Response to the Final Office Action dated September 9, 2003
Application Serial No. 09/539,228

other terminals. If other terminals access the demand-cast stream then they are also associated with the different demand-cast stream. The demand-cast streams (and list of demand-cast streams) are broadcast such that each of the associated terminals views the entire content (an IPG page) regardless of the point in time that they are associated with the demand-cast stream. The different demand-cast is part of the list as long at least one terminal is associated with the demand-cast.

The Applicants' claims 1 and 5 clearly recite that a different demand cast stream is added to a list of demand cast streams, by a requesting terminal and that the different demand cast stream is accessible from the list as long as one other terminal is associated with the different demand-cast stream. Further, claims 1 and 5 also recite that the all of the demand-cast streams have a respective IPG page associated with it.

In contrast, Eyer provides viewing of the demand data stream when information is requested that is not contained within the trickle data stream. Specifically, Eyer allows viewing of the demand data stream when the information contained within the trickle data stream is insufficient and does not modify a list of demand cast streams, as claimed by the Applicants. In this regard, the Applicants' invention teaches away from Eyer. Further, Eyer does not teach or suggest modification of its disclosure to allow accessibility of the different demand cast stream from the list of demand cast streams as long as one other terminal is associated with the different demand cast stream.

Further, the Applicants' invention also teaches away from Wolf. For example, Wolf transmits a live broadcast via common data stream. The look-ahead stream contains the same information as the common data stream and pointcasts a subset (the paused portion of the information not viewed from the common stream) of the information to be accessed by the viewer. Thus, Wolf does not transmit the same information to multiple users if they pause at different times and restart the transmission of the video program. Further, Wolf is silent with respect to the transmission of IPG pages.

"A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." *W.L. Core & Associated, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983) cited in Manual of

Response to the Final Office Action dated September 9, 2003
Application Serial No. 09/539,228

Patent Examining Procedure §2141.02, at 2100-122 (Rev. 1, Feb. 2003). Eyer and Wolf must each be considered as a whole. Because Eyer and Wolf each teaches away from the Applicants' claimed invention, these references do not render the Applicants' claimed invention obvious.

At least for the above reasons, the Applicants respectfully submit that independent claims 1 and 5 are not rendered obvious by Eyer or Wolf either individually or in combination. Further, dependent claim 2 (which depends directly from claim 1) contains the features of claim 1 and recites additional features therefor. As such, the Applicants submit that claim 2 is not obvious and fully satisfy the requirements under 35 U.S.C. §103 and is patentable thereunder, at least for its dependency upon non-obvious independent claim 1. Therefore, the Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of claims 1, 2, and 5.

B. Claims 3 and 4

The Examiner rejected claims 3 and 4 under 35 U.S.C. 103(a) as being unpatentable over Eyer in view of Wolf and further in view of Chernock. The Applicants traverse the rejection.

The arguments previously presented with respect to Eyer and Wolf are also applicable with respect to the rejection of claims 3 and 4. As such, and for brevity, the Applicants are not repeating those arguments but incorporate the arguments to distinguish the Applicants' claims 3 and 4 from the Examiner's cited references.

The addition of Chernock does not correct the shortcomings of Eyer and Wolf. Chernock discloses a system that enables the display or playing of audio, video, or graphics objects in tandem with the video and audio play of a digital video presentation. Specifically, allows a single version of material such as a cartoon presentation to be created and broadcast, yet be viewed and heard differently by various viewers, and tailored to them specifically. See Chernock at col. 2, lines 15-57. Thus, Chernock teaches the ability to insert personalized information into "holes" of audio and video program locations.

As argued in section A of this Response, the Applicant's claim 1 recites that a demand cast stream (i.e., a different demand cast stream and associated IPG page) is

Response to the Final Office Action dated September 9, 2003
Application Serial No. 09/539,228

added to a list of demand cast streams having respective IPG pages associated with each demand cast stream in the list and that the different demand cast stream is accessible from the list as long as one other terminal is associated with the different demand cast stream. As already argued in section A of this Response, Eyer and Wolf teach away from Applicants' claim 1.

In addition, and as explained above, Chernock does not teach or suggest modifying its disclosure that leads to the insertion of a different demand cast stream into a list of demand cast streams where the different demand cast stream is accessible from the list as long as at least one other terminal is associated with the different demand-cast stream. For example, Chernock teaches the addition of addition of data into holes of audio and video data to personalize the audio and video transmission for a particular user. In contrast, the Applicants teach modification of a demand cast stream list to include a different demand cast stream being accessible from said list as long as at least one other terminal is associated with said different demand-cast stream. In this regard, Chernock also teaches away from the Applicants' invention.

At least for the above reasons, the Applicants respectfully submit that independent claim 1 is not rendered obvious by Eyer or Chernock either individually or in combination. Further, dependent claims 3 and 4 (which depend either directly or indirectly from claim 1) contain the features of claim 1 and recite additional features therefor. As such, the Applicants submit that claims 3 and 4 are not obvious and fully satisfy the requirements under 35 U.S.C. §103 and are patentable thereunder, at least for their dependency upon a non-obvious independent claim. Therefore, the Applicants respectfully request reconsideration and withdrawal of the obviousness rejection of claims 3 and 4.

Rejections under 35 U.S.C. §102

The Examiner has rejected claims 6-8 under 35 U.S.C. §102(b) as being anticipated by Wolf. Applicants traverse the rejection.

The Applicants have presented, in section A above, distinctions with respect to the Applicants' invention and Wolf. Those distinctions are also applicable with respect

Response to the Final Office Action dated September 9, 2003
Application Serial No. 09/539,228

to the §102(b) rejection in this section. For brevity, the Applicants incorporate those distinctions in the current section.

Applicants' claim 6, recites in part:

sending to the session manager an acquisition message when the terminal acquires a demand-cast stream that is available for association of said terminal with said demand-cast stream by said session manager said demand cast stream comprising imagery associated with a program guide page;

sending to the session manager a release message when the terminal releases the demand-cast stream for dis-association of said terminal with said demand-cast stream by said session manager and determination by said session manager whether there are other terminals associated with said data stream; and

sending to the session manager a request message when the terminal needs to acquire a demand-cast stream that is unavailable.
(Emphasis added).

Applicants' claim 7, recites in pertinent part:

sending to the transport stream generator a stream released message when there are no longer any terminals acquiring a demand-cast stream comprising imagery associated with a program guide page; and

sending to the transport stream generator a stream requested message when a terminal requests a demand-cast stream that is not currently provided by the transport stream generator, for acquiring the demand-cast stream for the terminal, associating the terminal, and other terminals that request the demand-cast stream, with the demand-cast stream.
(Emphasis added).

Applicants send messages to the session manager so that the session manager can determine if a demand-cast stream is in use by a terminal. Each of the demand-cast streams has a respective IPG page associated with it.

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim" (Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984)(citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 U.S.P.Q. 193 (Fed. Cir. 1983)). (Emphasis added). As indicated above, Wolf does not teach the inclusion of a different demand-cast stream comprising imagery associated with a program guide page. Specifically, Wolf does not disclose sending messages towards the session manager for the purpose of "association of said terminal with said

Response to the Final Office Action dated September 9, 2003
Application Serial No. 09/539,228

demand-cast stream by said session manager said demand cast stream comprising imagery associated with a program guide page, as claimed by Applicants. As such, Wolf fails to disclose each and every element of the claimed invention. Therefore, Wolf does not contain each of the features recited by the Applicants claims 6 and 7. In addition, dependent claim 8 (which depends from claim 7) is also not anticipated by Wolf at least for its dependency upon claim 7.

As such, the Applicants submit that claims 6-8 are not anticipated and fully satisfy the requirements under 35 U.S.C. §102(b) and are patentable thereunder. Therefore, the Applicants respectfully request reconsideration and withdrawal of the rejection of claims 6-8.

CONCLUSION

Thus, the Applicants submit that none of the claims, presently in the application, is anticipated or obvious under the respective provisions of 35 U.S.C. §§102 and 103. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Frank W. Tollin, Esq. or Eamon J. Wall, Esq. at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

11/16/03

Eamon J. Wall, Registration No. 39,414
MOSER, PATTERSON & SHERIDAN, LLP
595 Shrewsbury Avenue, Suite 100
Shrewsbury, New Jersey 07702
Telephone: 732-530-9404
Facsimile: 732-530-9808
Attorney for Applicant(s)